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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/410,974	10/01/1999	ANDREW M. JONES	99-TK-252	7705

7590 10/04/2004
LISA K JORGENSEN
STMICROELECTRONICS INC
1310 ELECTRONICS DR
MAIL STOP 2346
CARROLLTON, TX 75000

EXAMINER

PHILPOTT, JUSTIN M

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/410,974

Applicant(s)

JONES ET AL.

Examiner

Justin M Philpott

Art Unit

2665

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action; or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____



HUY D. VU

SUPERVISORY PATENT EXAMINER

TECHNOLOGY CENTER 2600

Part of Paper No. 20040924

Continuation of 5. does NOT place the application in condition for allowance because:

Applicant's arguments are not persuasive.

Specifically, applicant argues that the combination of Carson and Katzman do not teach the limitation "formed within an integrated circuit" as recited in applicant's claims 1, 6 and 7. However, this limitation is clearly discussed in the previous office action which states on page 4:

"Further, Carson teaches the invention is an improvement over a specific integrated circuit (e.g., Intel's 82C59A and also Intel's 82380, see col. 1, line 57 - col. 2, line 55) comprising functional modules (e.g., 11-14, see FIG. 1). Thus, Carson anticipates that the invention may similarly be exemplified by an integrated circuit comprising the functional modules by teaching that the invention is an improvement over the prior art integrated circuit comprising functional modules. Furthermore, it is generally considered to be within the ordinary skill in the art to shift the location of parts absent a showing of unexpected results. Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to shift the location of any elements from a location outside of a common integrated circuit to a location inside of a common integrated circuit since it is generally considered to be within the ordinary skill in the art to shift the location of parts absent a showing of unexpected results. The contention of obvious choice in design can be overcome if Applicant establishes unexpected results. In *re Japikse*, 86 USPQ 70 (CCPA 1950). Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to include the elements taught by Carson within a common integrated circuit since Carson teaches that the invention is an improvement over the prior art integrated circuit comprising functional modules, and since it is generally considered to be within the ordinary skill in the art to shift the location of parts absent a showing of unexpected results."

More specifically, applicant then argues that "the Intel 82C59A and/or 82480 were marketed as members of 'chip sets', not stand-alone integrated circuits" (page 8). However, such an argument is moot for a number of reasons. First, applicant's claims clearly recite "[a]n integrated circuit comprising: ..." (emphasis added). That is, applicant has not claimed the recited functional modules of applicant's invention are contained in a stand-alone integrated circuit. Rather, by reciting "comprising", applicant has claimed an integrated circuit having the functional modules as well as possibly any other components common to an integrated circuit. Second, applicant has asserted particular marketing of a specific Intel product without providing any evidence to support such an assertion. Therefore, the alleged marketing of Intel cannot be reasonably considered by Examiner. Third, in the event applicant were to provide evidence regarding the marketing of these specific Intel products, such evidence cannot negate the clear teachings of the cited prior art. That is, Carson teaches an improvement over an existing integrated circuit, wherein the improvement comprises the functional modules as recited in applicant's claims. Accordingly, applicant's argument is not persuasive.

Still further, applicant argues that Examiner's statement, "it is generally considered to be within ordinary skill in the art to shift the location of parts absent a showing of unexpected results", is not supported by reference to authority. However, as recited in the previous office action, and repeated herein, authority is clearly provided by *In re Japikse*, 86 USPQ 70 (CCPA 1950). Furthermore, this argument regarding obviousness to shift the location of parts is an additional reason that the combination of Carson and Katzman teach all of the elements of applicant's claims. Both the teachings of Carson discussed above, and the authority provided by *In re Japikse* are clear indications that the combination of Carson and Katzman teach all of the elements of applicant's claims. Accordingly, applicant's argument is not persuasive.